REMARKS

Claims 141-240, 242-253 are pending. Claims 144-240 and 242-253 were withdrawn by the Examiner following the species election with traverse.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. The Rejection of Claim 141 under 35 U.S.C. 101 (Same Invention Double Patenting)

Claim 141 is rejected under 35 U.S.C. 101, as allegedly claiming the same invention as claim 1 of U.S. Pat. No. 6,352,851. The Examiner has correctly noted that claim 141 differs from claim 1 of US Patent No. 6,352,851 in that claim 1 of the patent is directed to a variant of SEQ ID NO:2 having 60% identity to SEQ ID NO:2, as opposed to claim 141, which is directed to a variant having 80% identity to SEQ ID NO:2. The Examiner states, however, that both claims include the alteration in SEQ ID NO2 in the alternative.

This rejection is respectfully traversed. Same invention-type double patenting is provided by 35 U.S.C. 101, which states "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent thereof." Same invention type double-patent precludes a second patent if it claims the identical subject matter as another patent. The test for determining whether claims of two patents define the same invention is "whether one of the claims could be literally infringed without infringing the other. If it could be, the claims do not define identically the same invention." *In re Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970). The Federal Circuit has refused to find the same invention-type double patenting based, among other things, "on the absence of cross-reading (whether the claims of one patent can be infringed wihotu infringing the other)." *Studiengesellschaft Kohle mbH v. Northern Petrochemical* Co., 784 F.2d 351, 355 (Fed. Cir. 1986).

Under the applicable test, claim 141 is not the same invention as claims 1 of the '851 patent because claim 1 can be literally infringed without infringing claim 141, e.g., with a glucoamylase variant defined by claimed but having 70% identity.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 101. Applicants respectfully request reconsideration and withdrawal of the rejection.

II. Obviousness-Type Double Patenting

Claims 141-143 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,352,851.

Applicants submit a terminal disclaimer to overcome this rejection. Applicants respectfully request reconsideration and withdrawal of the rejection.

III. Rejoinder of Claims 144-240 and 242-253

Claims 144-240 and 242-253 were withdrawn by the Examiner as a result of Applicants species election. As generic claim 141 is now in condition for allowance, Applicants respectfully request that the Examiner rejoin claims 144-240 and 242-253 pursuant to MPEP 809.02(a) and 37 C.F.R. 8.01.

IV. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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